

REMARKS

In response to the Office Action dated June 17, 2005, the Applicants have amended claims 1, 9, 17, 25 and 33. Claims 1-40 remain in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1-40 under 35 U.S.C. § 101, as being directed to non-statutory subject matter.

The Applicants respectfully traverse this rejection.

Namely, if a claimed mathematical algorithm or computer program is embodied in tangible hardware or produces a "useful, concrete, and tangible result" it cannot be rejected on the grounds of being non-statutory under 35 U.S.C. 101. AT&T Corp. v. Excel Communications, Inc., Docket No. 98-1338, (Fed. Cir. April 14, 1999). State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F. 3d 1368 (Fed. Cir. 1998).

The Applicants' amended claims are implemented in a tangible computer system and now explicitly include a computer implemented framework configured to create a graphical user interface that directly interfaces the service through the network to a user operating the application of the computer, which produces a **practical application** within the technological arts of allowing a user to interface with a computer network service that does not have a user interface with a computer implemented user interface framework. Therefore, since the Applicants' invention is embodied in a tangible manner and produces a practical application, it satisfies the requirement of 35 USC 101. Thus, the Applicant submits that rejection under 35 U.S.C. 101 should be withdrawn. State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F. 3d 1368 (Fed. Cir. 1998). Arrhythmia Research Technology Inc. v. Corazonix Corp., 958 F.2d 1053, 22 USPQ2d 1033 (Fed. Cir. 1992). *MPEP* 706.03 et seq.

Claims 1-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rajarajan (U.S. Patent Publication No. 2002/0156865). In particular, although the Examiner admitted on page 4 of the June 17, 2005 Office Action that "Rajarajan does not explicitly mention that his framework perform the function as claimed...", the Examiner continued to state that "...it would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that such functions would have been a matter of programming choice because those step/operations or functions are obviously a variation programming choices."

The Applicants respectfully traverse this rejection based on the arguments below.

In particular, the Applicants agree with a portion of the Examiner's statement, namely that the Rajarajan reference does not specifically disclose all of the features and functions of the Applicants' claimed framework implemented in a computer environment. However, the Applicants respectfully disagree with the Examiner's conclusion that the "...functions would have been a matter of programming choice because those step/operations or functions are obviously a variation programming choices."

First, the Examiner used improper hindsight to reject the claims. It is well-settled in the law that the Examiner cannot use knowledge and advantages from the Applicants' disclosure. Also, the Examiner cannot make conclusory statements regarding obviousness without providing some reason or motivation to recreate the Applicants' invention. An Examiner's argument that does not provide an explanation or specific reasoning for the claim of obviousness, but instead merely recites unsupported boilerplate rejection language is a clear indication that **hindsight** was used by the Examiner, which is insufficient to present a prima facie case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

The Examiner used improper hindsight to improperly conclude that the features and functions of the user interface framework include functions that "...would have been a matter of programming choice because those step/operations or functions are obviously a variation programming choices ...". The Applicants submit that just because the operations and functions of the claimed invention can be implemented with software programming does not mean that these functions and operations are necessarily obvious. **As long as these specific functions and features (regardless of whether they are capable of being implemented in software) are positively claimed (which they are) there still must be some reason, suggestion, or motivation found in the references whereby a person of ordinary skill in the field of the invention would make or use the functions.** In re Oetiker, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992) [emphasis added].

Next, the Examiner is reminded that even if the references in question seem relatively similar **"...the opportunity to judge by hindsight is particularly tempting.** Consequently, the tests of whether to combine references need to be applied

disclose the exact elements of the invention, which is the case here. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). [emphasis added]. Since the Examiner's rejection is based on hindsight, the rejection is improper and must be withdrawn. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.

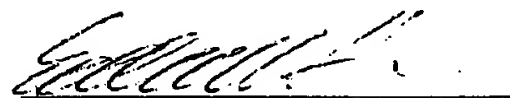
Accordingly, the combined cited references cannot render the Applicants' invention obvious. This failure of the cited references to disclose, suggest or provide motivation for the Applicant's claimed invention indicates a lack of a prima facie case of obviousness (MPEP 2143).

With regard to the rejection of the dependent claims, because they depend from the above-argued respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable (MPEP § 2143.03).

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicants' attorney at (818) 885-1575 if the Examiner has any questions or concerns. Please note that all correspondence should continue to be directed to:

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Respectfully submitted,
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